

REMARKS

In response to the Office Action dated March 28, 2008, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the following comments. By way of summary, Claims 1-7 and 9-10 remain pending. Claim 1 has been amended to add language inadvertently omitted from the prior version of the claim.

Claims 1-7 and 9-10 Are In Condition for Allowance

Claims 1-7, 9 and 10 presently stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of one or more of Tremulis, Burns, Abiuso, and Reynolds. Applicant respectfully disagrees and traverses the rejection for the following reasons.

Claim 1, recites, *inter alia*, an “elongated member permanently positioned within [a] tube... formed of a porous material that becomes saturated with a fluid introduced within said tube.” In clear contrast, Wang teaches a non-porous inner tube containing inner ports disposed within an outer tube containing outer ports. Wang’s catheter is configured to “balance the fluid flow rate (a) by providing a smaller ratio of inner ports to outer ports in the proximal portion than in the distal portion, and/or (b) by providing a shorter average flow distance between the more distal inner and outer ports than between the more proximal inner and outer ports.” Col. 3, ll. 36-42. The Office Action acknowledges that Wang does not disclose the above-recited limitation of Claim 1. However, it contends that replacing the inner tube of Wang with a “porous tube” would involve only the “simple substitution of one equivalent for another.”

The Examiner’s position neglects to take into account that the proposed modification changes the principle of operation of the Wang catheter. Section 2143.01 of the M.P.E.P. states that “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious.” (citing *In re Ratti*, 270 F.2d 810 (CCPA 1959).) Wang is concerned with enabling a more uniform fluid flow rate from different regions of a catheter’s infusion section. See, e.g., Col. 3, ll. 58-60. In clear contrast to the Examiner’s proposed modification, however, Wang states that “both of [the] flow balancing mechanisms” of his invention “depend on providing concentric tubes 32 and 38 in infusion section 60 *and on the relative placement of ports 48 and 50 in these tubes.*” See, Wang, Col. 5, ll. 42-46 (emphasis

added). At least because the proposed modification would change the principle of operation of the Wang catheter, Applicants submit that no prima facie case of obviousness has been established.

Moreover, the presently claimed catheter possesses important advantages over the Wang catheter. In describing one non-limiting embodiment of the claimed catheter, the present specification discloses that as fluid enters the infusion section, it “diffuses longitudinally within the walls of the tubular member 54. Once the membrane 54 is saturated, the fluid passes through the membrane 54 and exits the catheter 50 by flowing through the exit holes 56 of the tube 52.” See ¶ [0055]. The specification further explains how this configuration results in a “substantially uniform flow through all of the exit holes 56,” thus enabling fluid delivery at a “substantially equal rate throughout the wound area of the anatomy.” *Id.*

The catheter recited in Claim 1 thus provides a significant advantage over the Wang catheter by not requiring the careful relative placement of ports in inner and outer tubes. Additionally, as described in the present application, the Wang catheter “is only effective for relatively high pressure fluid delivery.” ¶ [0009]. Under low pressure conditions, “the fluid tends to exit through the side holes of the inner and outer tubes” nearest the proximal end of the infusion section. *Id.* In view of the differing mechanism of operation of the claimed catheter and its numerous advantages over the cited prior art, Applicant submits that Claim 1 would have not been obvious to one of ordinary skill in the art.

Accordingly, it is submitted that Claim 1 is in condition for allowance. Claims 2-7 and 9-10 are allowable, not only because they depend from allowable Claim 1, but upon their own merit as well.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present

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disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims and specification. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, Curtiss Dosier at (949) 721-7613 (direct line), to resolve such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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